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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,940	03/23/1999	TIMOTHY CUNNINGHAM	2204/116	9148

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EXAMINER

ABELSON, RONALD B

ART UNIT	PAPER NUMBER
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2666

DATE MAILED: 11/18/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/274,940

Applicant(s)

CUNNINGHAM ET AL.

Examiner

Ronald Abelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 22-61 is/are allowed.
- 6) ☒ Claim(s) 1,3,5 and 9 is/are rejected.
- 7) ☐ Claim(s) 2,4,8 and 10-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Allowable Subject Matter

1. The indicated allowability of claims 1-5 and 9 is withdrawn in view of Itoi.

Claim Objections

2. Claim 9 is objected to because of the following informalities: Claim 9 is dependent on claim 6, which has been deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Itoi (US 6,456,625).

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5. Regarding claim 1, Itoi teaches a method and apparatus for translating addresses in a communication network having multiple overlapping address domains (fig. 3B box 321). The method comprises receiving an overlapping local address from an inbound address domain wherein the overlapping local address is a destination host local address from a destination address domain ("1120", col. 12 lines 13-16); and translating the overlapping local address from the inbound address domain into a unique global address that is specific to a specified outbound address domain (global IP address of "B", col. 12 lines 32-35).

Regarding the step receiving a translation request message as part of a domain name resolution procedure, the examiner contends that the arrival of the packet at the conversion module (fig. 3B box 321) is a translation request. Furthermore, when dialing a telephone number, one must include the local address (7 digit phone number) and the outbound address domain (3 digit area code). Note, Itoi represents the 10 digit phone number with the four digit number "1120".

Regarding claim 3, the step of translating the overlapping local address from the inbound address domain comprises the steps of maintaining and finding are performed by receiving a

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local telephone number "1120" and mapping it to a specific global address (col. 12 lines 13-16, 32-34).

The step of extracting the unique global address from the address translation entry is performed when the packet reaches the destination node (col. 12 lines 52-54).

Regarding claim 5, selecting a network address from among a number of available network addresses (col. 12 lines 32-34); creating an address translation entry having the inbound local address field equal to the local address ("1120", col. 12 lines 13-16), the outbound address domain field equal to the specified outbound address domain ("1120", col. 12 lines 13-16), and the outbound global address field equal to the selected network address (global IP address of "B", col. 12 lines 32-35). Note, the examiner maintains that the telephone # 1120 could be viewed as containing both an area code as well as a local phone number.

Regarding claim 9, transmitting a translation response message including the unique global address. The translation response message could be viewed as the NAT sending the packet to the destination node (col. 12 lines 32-35).

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Response to Amendments

6. Applicant's amendments filed 7/28/2003, with respect to independent claims 22, 39, 56, and 60 have been fully considered and are novel. A subsequent search did not find the limitations taught by the claims.

Allowable Subject Matter

7. Claims 22-61 are allowed.

8. Claims 2, 4, 8 and 10-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter.

Regarding claims 22, 39, 56, and 60, although Itoi teaches receiving a packet from a source host in a source (inbound) address domain that is destined for a destination host in a destination (outbound address domain, the packet including a source address equal to an overlapping source host local address from the source (inbound) address domain and a destination address equal to a unique destination global address, however nothing in the prior art of the record teaches or fairly

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suggests translating the overlapping source host local address from the source (inbound) address domain into a unique source host global address that is specific to a specified outbound address domain. In contrast, Itoi teaches translating the overlapping source host local address from the source (inbound) address domain into a unique destination host global address that is specific to a specified outbound address domain.

Regarding claim 2, although McCann teaches selecting the unique global address from among a number of available global network addresses (dynamic IP address), one of ordinary skill in the art would not be motivated to combine the reference with the system of Itoi.

Regarding claim 8, nothing in the prior art of the record teaches or fairly suggests the outbound address domain is a source address domain in combination with the other limitations listed in the claim. In contrast, Itoi teaches the outbound address domain is a destination address domain.

Regarding claim 10, nothing in the prior art of the record teaches or fairly suggests receiving a packet with a destination

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address equal to a unique destination host global address, in combination with the other limitations listed in the claim. In contrast, Itoi teaches translating the packet into a unique global address that is specific to a specified outbound address domain.

Response to Arguments

9. Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection. The examiner agrees with the applicant that Luciani fails to teach translating the overlapping local address from the inbound address domain into a unique global address that is specific to a specified outbound address domain. Therefore a new search was performed.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Abelson whose telephone number is (703) 306-5622. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be


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reached on (703) 308-5463. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.


Ronald Abelson
Examiner
Art Unit 2666

November 4, 2003



DANTON
PRIMARY EXAMINER